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## REMARKS

Claims 1-47 and 53-60 remain pending.

In the Office Action, the Examiner rejected claims 33, 34, 39, 41, 42, 46, 47, and 60 under 35 U.S.C. § 103(a) as being unpatentable over Gerber et al. (U.S. Patent No. 5,657,383) in view of Lee (U.S. Patent No. 5,537,470); stated that claims 1-32 and 53-59 are allowed; and stated that claims 35-38, 40, and 43-45 would be allowable if rewritten in independent form.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143.

Applicant respectfully traverses the § 103(a) rejection of claims 33, 34, 39, 41, 42, 46, 47, and 60 over Gerber et al. in view of Lee. A *prima facie* case of obviousness has not been established, at least because the references when combined fail to teach all elements of the claims. Independent claims 33 and 60 require a method and article including, *inter alia*, "instructing said caller to call back later." The combination of Gerber et al. and Lee fails to teach or suggest all elements of the method and article of claims 33 and 60.

As admitted on page 3 of the Office Action, Gerber et al. fails to teach or suggest instructing a caller to call back later. (See also Fig. 4, block 223: "call automatically returned").

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Lee also fails to teach or suggest instructing a caller to call back later, as required by claims 33 and 60. Col. 5, lines 36-38, of Lee teaches only that:

As shown in operation block 216, a caller may be disconnected during the call, either intentionally or inadvertently, and for any of a number of reasons.

While this portion of Lee arguably discloses disconnecting a caller, it does not teach or suggest instructing a caller to do anything. Col. 5, lines 41-46, of Lee provides only that:

a caller who calls back the service provider within the predetermined time may be directed to the agent which serviced the original call. In operation block 220, the caller previously connected to an agent places a subsequent call to the service provider, by again dialing the appropriate number.

While this portion of Lee arguably discloses a caller calling back, it does not teach or suggest that such a call is in response to any instructions.

Nor do these, or any other, portions of Lee implicitly or inherently teach or suggest "instructing said caller to call back later" as set forth in claims 33 and 60. For example, col. 5, lines 36-38, provides that the call may be disconnected inadvertently. Such teaching of inadvertent disconnection argues against any instruction to call back prior to disconnection. The teaching in this section of Lee of intentional disconnection also does not suggest instructing a caller to call back, because such may be "for any of a number of reasons" (col. 5, line 38). At least some of these reasons would not involve instructing a caller to call back; hence, intentional disconnection does not suggest instructing a caller to call back later.

Because the combination of Gerber et al. and Lee fails to teach or suggest at least the above-quoted element of claims 33 and 60, a *prima facie* case of obviousness has not been

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established for these claims. Dependent claims 34, 39, 41, 42, 46, and 47 are allowable at least by virtue of their dependence on claim 33.

A *prima facie* case of obviousness also has not been established for claims 33, 34, 39, 41, 42, 46, 47, and 60, because no motivation has been provided to combine Gerber et al. and Lee. The proposed justification on page 3 of the Office Action, "the caller might not be available when the call back is made," is conclusory and devoid of citation to either reference. Such a bare conclusion does not establish a *prima facie* case of obviousness without evidence supporting that conclusion. Presumably the inventors in Gerber et al. were aware of possible difficulties with an automatic call back scheme, and yet this is the scheme that they chose. No reasoning, in the references or otherwise, has been provided detailing what deficiency or need in the automatic call-back scheme of Gerber et al. that would have motivated one of ordinary skill in the art to do away with such a scheme in favor of one where a caller is instructed to call back. In the absence of such evidence, a *prima facie* case of obviousness has not been and cannot be established for claims 33, 34, 39, 41, 42, 46, 47, and 60.

A *prima facie* case of obviousness also has not been established, because at least Gerber et al. and Lee teach away from the proposed combination. See M.P.E.P. § 2145(X)(D) ("proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference"). As is apparent from Fig. 2, elements 223 and 229, Gerber et al. discloses queuing a call for automatic call back to a caller when a placeholder is reached in the queue. By contrast, Lee discloses in Fig. 2 a scheme where a caller calls back

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(block 220) *after* connection with an agent (block 208) and later disconnection from that agent (block 216).

Permitting a caller to call back as in Lee would change the principle of operation of the automatic call return scheme disclosed in Gerber et al. The principle of operation in Gerber et al. is for an automatic call to the caller *when a placeholder is reached when servicing a queue* (col. 7, lines 16-18), and allowing a user to call back as in Lee would render unsatisfactory the ready-for-service operating principle in Gerber et al. Also, the principles of operation in Lee (i.e., connection to an agent and re-connection to that agent (Fig. 2, blocks 208 and 232) would be changed if combined with Gerber et al. where a call is placed in a queue before a caller speaks with an agent (see Fig. 2, the blocks between 201 and 229). Thus, both references teach away from the proposed combination. A *prima facie* case of obviousness has not been established for claims 33, 34, 39, 41, 42, 46, 47, and 60 for this additional reason.

Reconsideration and allowance of pending claims 1-47 and 53-60 is respectfully requested.

In the event that any outstanding matters remain in this application, Applicant requests that the Examiner contact Alan Pedersen-Giles, attorney for Applicant, at the number below to discuss such matters.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-0221 and please credit any excess

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fees to such deposit account.

Respectfully submitted,

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